

Serial No. 09/704,838

In reply to: Office Action mailed October 20, 2006

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**REMARKS**

This is in response to the Office Action mailed on October 20, 2006. Claims 1-25 are pending in the application and are rejected. With this response, claims 1, 9, and 18 are amended. The remaining claims are unchanged, and no new claims are added.

Claims 1-25 were rejected under 35 U.S.C. 103(a) as being obvious over Wolfberg, in view of Sullivan and Ferry. The Office Action also takes official notice of old and well known prior art that could be combined with the references to argue unpatentability. With this response, the rejection is traversed and the claims are amended to further distinguish the claims from the prior art.

First, Applicants respectfully traverse the arguments made in rejecting the claims in the previous Office Action. More specifically, Applicants point to the Response to Arguments on page 6 of the Office Action. For example, Applicants argued that "these different types of services [of the prior art] are distinguishable from the different 'amounts of portfolio modeling and coaching'."

The Office Action initially argues that "Wolfberg teaches 'based on [the selected service level]'. Wolfberg describes 'other services' could be added, it is inherent in this explanation that variable levels of the similar services could be offered." Applicants respectfully point out that the definition of "inherent" as used in the Office Action than in the law. The law states that "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." MPEP 2112, IV, quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). According to this definition, the prior art teaching does not make inherent that "variable levels of similar services could be offered." Instead, one skilled in the art could read this to understand that different and unrelated services can be offered to provide a multi-function experience.

The Office Action also goes on to argue that "Both 'check writing' and 'credit card purchase' (two examples given in the description) could be considered variable levels of 'banking services'." The Applicants have argued that different types of services are distinguishable from the different "amounts of portfolio modeling and coaching" as set forth

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in the claim. Regardless of the Office Actions interpretation of "amounts of [service]," as set forth in the claim, to include credit card and checking as variable levels of banking service, the prior art does teach or suggest the elements of the claim. Specifically, the prior art does not teach or suggest with its credit card and checking services that "each service level includes a unique combination of amounts of portfolio modeling and coaching available to the user" as set forth in the claims.

Second, the claims have been amended to include features that are not shown or suggested in the prior art. According to the Office Action, Wolfberg inherently describes that variable levels of the same service could be offered, such as credit card purchases and check writing as variable levels of banking services. This teaching is contrary to the amended features of the claims, where such a feature is not possible. For example, the claims set forth the "plurality of user selectable service levels [are] for a user to select one of the service levels." This feature is not possible in Wolfberg. Wolfberg does not offer a plurality of services for the user to select one; Wolfberg provides several of its services to all of the users. To make a user choose one would be contrary to the teaching of Wolfberg, which is useful because it offers and provides to all users several services. For Wolfberg to teach or suggest the features of the amended claims, the user would have to select credit card purchases OR check writing.

In addition, Sullivan does not teach or suggest the features of the amended claims because it provides only computer technical support. The suggestion that Wolfberg could provide an investor self-help system is only hindsight. Neither Wolfberg nor Sullivan teach or suggest that "each service level includes a unique combination of amounts of portfolio modeling and coaching available to the user, and . . . a selected amount of dialogue and instructions between the user and a live advisor" as set forth in the amended claims. Ferry does not teach or suggest these features either.

Because the features of the amended independent claims 1, 9, and 18 are not shown or suggested in the prior art and the references separately, they cannot be found in any proposed combination of the prior art. Further, claims 2-8, claims 10-17, and claims 19-25 depend either directly or indirectly from independent claims 1, 9, and 18, respectively. By virtue of their dependency, these claims are patentably distinguishable from the prior art and references, also.

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**CONCLUSION**

Accordingly, Applicants respectfully request removal of the objections and rejections, and for favorable action and allowance of the application. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7340. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-375602).

Respectfully submitted,

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